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In re application of :  
Eiichi Kitazono, et al. : DECISION ON  
Serial No. 09/744,684 : PETITION  
Filed: January 29, 2001 :  
For: ADHESIVE AGENT COMPOSITION, AND PERMEABLE ADHESIVE TAPE,  
ADHESIVE DRUG COMPOSITION AND ADHESIVE TAPE PREPARATION CONTAINING  
THE ADHESIVE AGENT COMPOSITION

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION mailed November 17, 2003.

On March 11, 2003, a non-final office action was mailed to applicants rejecting all of the claims over 35 USC 103. A reply to the office action was filed by Applicant on August 11, 2003. In the reply, Applicants did not amend the claims. Additionally, applicants submitted an Information Disclosure Statements on July 18, 2003. On November 17, 2003, a final office action was mailed. A new ground of rejection under 35 USC 103 was applied by the examiner over all of the claims.

On January 15, 2004 the instant petition under 37 CFR 1.181 was timely filed to formally request the withdrawal of finality of the November 17, 2003 office action.

Petitioner argues that finality of the office action is improper because the examiner improperly applied Section 706.07 of the MPEP.

## DECISION

Section 706.07 of the MPEP states:

### 706.07(a) Final Rejection, When Proper on Second Action

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

The examiner states in his office action that the office action was made final because the new ground of rejection was based on information submitted in an information disclosure statement filed on July 18, 2003 filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

It is noted that the Information Disclosure Statement filed on July 18, 2003 was filed with a certification that each item contained in the IDS was first cited in a communication from a foreign patent office not more than three months prior to the filing of said IDS. No fee under 37 CFR 1.17(p)

was required or submitted. Therefore, the finality based on using the information in an information disclosure statement in which a fee had been paid is improper.

Petitioner also notes that the examiner cited all of the references relied upon in the final rejection in the first office action so therefore, the new grounds of rejection were not necessitated by the IDS. This is also a persuasive argument.

Therefore, the final office action mailed November 17, 2003 was improperly made final. Accordingly, the petition for withdrawal of finality is **GRANTED**.

It is also pointed out that while the finality of the office action has been withdrawn, the rejection still stands and applicants period for response continues to run from the date of the office action.



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